REMARKS

Claims 20-39 were pending in the present application. By virtue of this response, claim 38 has been cancelled, claim 20 has been amended, and no new claims have been added. Accordingly, claims 20-37 and 39 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

Claim Objections

Claim 38 stands objected to under 37 CFR 1.75 as being a substantial duplicate of claim 37. In response, Applicants hereby cancel claim 38 and request withdrawal of the objection.

Claim Rejections Under 35 U.S.C. §103(a)

A. Claims 20, 23-27, 30-33, 36, and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kroeker et al. (U.S. Patent No. 6,073,232; hereinafter "Kroeker") in view of Reed et al. (U.S. Patent No. 6,209,070; hereinafter "Reed") and further in view of Park (U.S. Patent No. 6,195,217).

Applicants respectfully traverse the rejection and submit the Examiner has failed to present a *prima facie* case of obviousness. The applied references, taken alone or in combination, fail to disclose or suggest all the features of the present claims. In particular, Applicants submit that the combination of references fails to disclose or suggest a method of transferring data from a disc drive to a host that includes "creating a host file structure comprised of data to be transferred to the host", and "producing a client files not transferred data structure comprised of data in the host file structure that has not been transferred to the host," as recited by claim 20. Similar features are recited in independent claims 27 and 33.

The Examiner states that Kroeker discloses "creat[ing] a host file structure comprised of data to be transferred to the host (see lines 30-65 of column 2)..." Applicants respectfully disagree. Applicants note that Kroeker is directed to caching files on a hard drive for potential use when a processor is coupled to the hard drive and to which the hard drive supplies data resets and/or reboots (see Col 2, Lines 30-47). Even assuming Kroeker discloses caching of files for potential request by a processor, however, Kroeker does not disclose or suggest forming a host file structure comprised of data "to be transferred to the host." Kroeker discloses a system for keeping a group of files in a disc cache memory (Col 2, Lines 39-42), some of which might be transferred to a host after a subsequent reset (Col 2, Lines 38-39) and when requested by the host: "[i]n response to a subsequent read command from the host computer, it is determined whether records requested...are stored in the data cache." (Col. 2, 41-43)(Emphasis added). By contrast, the present claims include the features of forming "a host file structure comprised of data to be transferred to the host," where the steps are repeated until all of the data in the host file structure has been transferred to the host. The addition of Reed and Park do not cure the deficiency of Kroeker, nor are they alleged to in the Office Action. Accordingly, Kroeker, alone or in combination with Reed and Park, fails to disclose or suggest this feature of the present claims and the rejection should be withdrawn.

The Examiner further states that Reed discloses "producing a files not transferred data structure comprised of data in the host file structure that has not been transferred (i.e. the difference between has to be transferred and what has been transferred) (see lines 53-67 of column 2)." Applicants respectfully disagree. Applicants note that although Reed appears to involve data structures and processing of data transfers, Reed teaches, at Col. 2, lines 53-65, using a data structure that indicates the source storage locations from which data was transferred during a first transfer, processing a second data transfer from a plurality of source storage locations to a plurality of target storage locations, and then processing the data structure to determine source storage locations involved in the second transfer that were not involved in the first transfer. By contrast, claim 20 includes producing a client files not transferred data structure comprised of data in the host file structure that has not been transferred to the host. Assuming *arguendo* that Reed teaches

creating a data structure indicating source storage locations from which data was transferred, Reed still does not disclose or suggest producing a client files not transferred data structure.

Also, Reed discloses identifying which "source storage locations included in the second data transfer that were not involved in the first data transfer." (Col 2, Lines 62-63) Thus, Reed discloses a system where as between two transfers, one transfer may have some source storage locations in common with the other transfer and some not in common. By contrast, claim 20 includes a client files not transferred data structure comprised of data in the host file structure that has not been transferred to the host, and transferring the data in the client files not transferred data structure to the host. Thus, the data structure, the comparison, and the transfers in Reed are different than the features of the present claims. Accordingly, the rejection should be withdrawn and the claims allowed.

Independent claim 27 includes (c) creating a host file structure in the storage device that is comprised of data in the file data structure (d) producing a client files not transferred data structure in the storage device that is comprised of data in the host file structure that has not been transferred to the host. Thus, the above discussion of Kroeker and Reed applies equally to claim 27, and claim 27 therefore is allowable for at least similar reasons as claim 20.

Independent claim 33 includes a client interface program for causing a processor to create a host file structure comprised of data to be transferred to the host, to produce a files not transferred data structure comprised of data in the host file structure that has not been transferred and to transfer the data in the files not transferred data structure to the host. Thus, the above discussion of Kroeker and Reed applies equally to claim 33 and claim 33 is therefore allowable for at least similar reasons as claim 20.

B. Claims 21, 22, 28, 29, 34, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kroeker in view of Reed in view of Park as applied to claims 20, 27, and 33 above, and further in view of Glover (U.S. Patent No. 6,282,045).

Claims 21, 22, 28, 29, 34, and 35 depend variously from independent claims 20, 27, and 33 and are allowable over the combination of Kroeker, Reed, and Park for at least similar reasons discussed above. The addition of Glover does not cure the deficiencies of Kroeker, Reed, and Park, nor is Glover alleged to in the Office Action. Accordingly, Applicants request withdrawal of the rejection and allowance of the claims.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 146712007500. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 16, 2004

Respectfully submitted,

By_____
Christopher B. Eide
   Registration No.: 48,375
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304
(650) 813-5720